

Docket No.: 1484.1007

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Chikako KARIYA

Serial No. 09/938,485

Group Art Unit: 2178

Confirmation No. 2872

Filed: August 27, 2001

Examiner: Cesar B. PAULA

For: RELATED DOCUMENTS PROCESSING DEVICE, RECORDING MEDIUM FOR
PROCESSING RELATED DOCUMENTS AND METHOD FOR PROCESSING
RELATED DOCUMENTS

REPLY BRIEF UNDER 37 C.F.R §§ 41.41

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Entry of this Reply Brief is respectfully requested. This Reply Brief is submitted in response to the Examiner's Answer, mailed October 5, 2007.

I. Status of Claims

Claims 1-8, 10-18, 20-27, 29-37, 39-46 and 48-56 are pending in this application at the filing of the Appeal Brief, claims 9, 19, 28, 38, 47, and 57 have been canceled.

Claims 1-8, 10-18, 20-27, 29-37, 39-46 and 48-56 have been rejected at least twice.

II. GROUNDS OF REJECTION

Claims 1-8, 10-18, 20-27, 29-37, 39-46 and 48-56 stand rejected under 35 U.S.C. 103 as being obvious over Moody et al., US Patent No. 5,890,177, in view of a portion (pages 365-394 and 396-401) of Microsoft publication "Getting Results with Microsoft Office 97' (hereinafter "Office 97").

III. ARGUMENT

OBVIOUSNESS OF MODIFYING MOODY ET AL. FOR EMAIL BODY USAGE

As set forth in the Appeal Brief, the Examiner has previously been unclear what element of Moody et al. or of the modified Moody et al. would meet the claimed "document", with the independent claims requiring the document to be an email.

Of the available interpretations of "documents" with regard to email, either as an attachment to an email, as the email itself, or as the body of the email, the Examiner's Answer appears now to state that the document in the modified Moody et al. is carried in the body of the email.

Conversely, previously the Examiner had relied upon the word processing documents of Moody et al., as reading on the claimed document. However, the word processing documents of Moody et al. would only correspond to the word processing document attachment to an email.

Thus, the Examiner's Answer newly sets forth that the Examiner's proposed modification of Moody et al. is based upon a premise that if the invention of Moody et al. were to be implemented in email bodies, rather than Word documents, then the modified Moody et al. would implement the claimed invention. As noted, previous rejection rationales were unclear how Moody et al. was being modified, merely indicating that a combination of Moody et al. with Office 97 would disclose the claimed invention, while relying on the unmodified Moody et al. to disclose a majority of the dependent claims. See page 9-10 of the Examiner's Answer.

In responding to applicants previous Appeal Brief remarks, the Examiner's Answer proceeds on pages 9-10 to explain how such a modified Moody et al. would then necessarily meet the claimed invention.

As previously noted, Moody et al. sets forth that copies of an original document can be transmitted to different reviewers, then upon receipt by the different reviewers, the modified copies can be compared and merged into a single easily reviewable document. Moody et al. in col. 7, lines 21-67 and col. 4, lines 34-51, as relied upon by the Examiner.

Again, Moody et al. merely indicated that a document, e.g., a word-processing document, can be copied, and those copies can be distributed to different reviewers through email. After review, the edited copies of the original document can be received by the original author, e.g., via email, and differences between the original and the different edited copies can be illustrated in a single merged document. See FIG. 3 of Moody et al. showing such a single merged document.

The background of Moody et al. indicates that conventional reviewing techniques included a document being sent sequentially to different reviewers, or such different reviewers looking at the same document at the same time and making changes that can be seen by all reviewers. See Moody et al. in col. 1, line 31, through col. 2, line 19.

Thus, the purpose and direction of Moody et al. is for improving the method used for reviewing a single document. This improvement is achieved by permitting different reviewers edit copies of an original document and a merging program compare those edited copies with the original document for showing the original author a single document with all proposed edits of the original document.

The Examiner has indicated that it would have been obvious to modify Moody et al. to implement the same system through exchanges of email bodies, compared to exchanges of email attachments.

However, a prima facie obviousness case requires a reasonable expectation of success.

There is insufficient evidence in the record that such a modified system would operate or achieve the goals of Moody et al., without substantial experimentation, i.e., it is respectfully submitted that the change of Moody et al. to an email body comparison system would require more than a minor change of Moody et al. to send document contents within the email body and still achieve the goals and purpose of Moody et al..

The Examiner has only noted that Office 97 sets forth emailing Word document contents within the body of an email, and further discloses sending our request for recipients to respond to an invite. Briefly, the Examiner has further indicated that the disclosure of an Email client by Office 97, which can organize received emails, can also be incorporated into Moody et al. for selective organizing of emails in a time-wise manner.

However, it is respectfully submitted that these modifications of Moody et al. are not insubstantial.

Presumably, the Examiner's proposed modified Moody et al. would generate an original document, then copy that document contents into the body of an email and then email the same email to multiple recipients. Then, the proposed modified Moody et al. would have to manage received modified emails to discern between contents of the emails that are actually the modified email body contents and not a repetition of the original email, e.g., a reply email copying the original email, and different modifications to the body of the email depending on the email client that received the original document email, modified the same, and then replied or sent an email back to the original sender. Further, some email clients may strip headers and IDs from

enclosed body contents of emails during receipt or sending, e.g., if an email client is set to only receive plain text. The modified Moody et al. system would also have to have an email filtering system to potentially prevent the email client from changing received emails differently from other non-reviewed content emails. Still further, such a modified Moody et al. system would need some means for converting the contents of each of the received emails or a means for the email client to implement a review of the email contents to implement the invention of Moody et al., and ultimately generate either an email or converted combined document showing all the changes.

Lastly, as noted on page 16 of the Examiner's Answer, "[t]he Examiner [is] interpreting the document to be the body of the email, which does not destroy the creator id and timestamp taught by Moody, since the email contains document information, and the email header information separately within the email message." The Examiner further provides an example of a reference apparently describing using RTF format text within an email body. Regardless, similar to above, for the Examiner's modification of Moody et al. to work, the email body must maintain the ID, header information, and time-stamp information described in Moody et al., along with the remaining document data. However, except for providing an example of an RTF document format being used in one email format, the Examiner has failed to provide evidence that such required information will likely or reasonably be available in email bodies. A *prima facie* obviousness case requires the likelihood of success to be reasonable, which is not supported by the evidence in the present application.

In addition, the Examiner indicates such a modification of Moody et al. would have been beneficial because "[t]his would provide the efficient, and time-saving benefit of directly emailing the documents the user has created using the sophisticated features of the application, such as the wordprocessing application." The Examiner further argues on page 13 of the Examiner's Answer that the proposed modification of Moody et al. is more efficient since it can be done upon receipt of the email, while in the inbox of the email client.

Thus, the Examiner indicates that the modified Moody et al. would have been beneficial since email clients are easier and email is more efficient, and that using the email client to implement the invention would be quicker and more efficient.

However, as noted above, to change Moody et al. to be implemented in an email environment would require substantial changes and/or additions to Moody et al. not supported by the record. Further, the changing of the typical email claim to implement the system of Moody et al. would require substantial changes.

Conversely to the above mentioned additional changes and/or additions that would be required by a modified Moody et al., it is respectfully submitted that the existing sending of attachments by Moody et al. is more simple and more efficient.

Since the documents contain all the data identifying the original author and modifying authors, and include all the same word processing settings for that document, e.g., fonts, margins, styles, spelling and grammar preferences, etc., the original author of Moody et al. does not need to worry that a received modified document will be of an incorrect format or require any special handling. Since the documents are derived from the author's document they keep the original embedded information, as well as any embedded information for a reviewer's modification, which would probably not be the case with relies via email.

Thus, it is respectfully submitted that it would not have been obvious to modify Moody et al. to be implemented through the body of emails, as such a change is less desirable, requires substantial changes and/or additions to Moody et al., and has an unreasonable chance of success. Lastly, it is further submitted that the disclosure of Office 97 is not enabling for such required changes and/or additions.

MODIFIED MOODY ET AL. STILL FAILS TO DISCLOSE ALL FEATURES

Email Exchange History of a Branching of Separate Emails from a First Email

Beginning on page 10 of the Examiner's Answer, the Examiner explains that the proposed modified Moody et al. would disclose the claimed emails having to have an email exchange history of a branching of separate emails form a first email, stating that Moody et al. sets forth a detecting of "an exchange history of documents" when a heritage comparison is done on a document to determine their relatedness, i.e., whether a document is a copy of an original document, and that this "exchange history of documents" in combination with Office 97 indicating that an originating user can email multiple people and receive responses meets the claimed exchange history of branching of separate emails. The Examiner on page 12 further cites the use of an email client of Office 97 to permit a user to group emails for supporting the Examiner's branching argument.

Briefly, however, claim 1, for example, sets forth that a detector detects "relevance information" which includes the "email exchange history of a branching of separate emails from a first email." Thus, the claimed detector and relevance information must also be met.

Regardless, the Examiner has proposed modifying Moody et al. to be implemented through emailing text, presumably, within the body of an email to a number of reviewers, receiving a modified version of that text in another email from the reviewers, and then somehow

performing the invention on the contents of the different received emails to produce either a combined email body with evidence of the reviewer's changes or a combined document with the same.

Thus, with such an implementation, the system of the modified Moody et al. would still only perform the heritage comparison of Moody et al., by comparing something within the body of each email to identify that email as being related to an originally sent email. That comparison would be on an email by email basis and individual to that email. Any combination of information based upon the detection of such heritage information would no longer need that heritage information and merely combined as suggested by Moody et al. in a single document.

The fact that Office 97 further sets forth a feature of reviewing received emails in a filterable list, such as in an inbox, based upon receive time, would not have any relevance to Moody et al. Thus, however the timewise collection of multiple emails in list could be interpreted, there would not have been any reason for the modified Moody et al. to implement such a system. The same would merely add a feature unrelated to the invention/purpose of Moody et al.

Moody et al. is not directed to showing the original author the different emails or documents in a listed fashion such as an email inbox listing, but rather performing an automatic operation on the contents of those documents to create a single easily reviewable document.

Further, any receipt of emails and listing of the same in an email client cannot be considered an email exchange history of a branching of separate emails from a first email. The listing of emails is merely that, not an exchange history of a branching of emails.

Branching of Emails

The independent claims further note that this "branching of emails" includes "at least two distinct time-wise non-sequential emails branching from the first email on a same branch of the branching of emails and/or at least two distinct time-wise sequential emails branching from the first email on different branches of the branching of emails."

The mere listing of emails in a time-wise fashion cannot be considered an exchange history of such branched email.

Still further, even if the listing of emails in Office 97 were interpreted as potentially listing emails that fall within the claimed branching, there is still no reason for the modified Moody et al., or for further modifying Moody et al., to use or rely on such a listing.

The system of Moody et al. is designed to operate automatically to collect the modified changes and merely place them in a combined document. There is no need of additional information of time-wise receipt of the documents or emails or of any branching of emails.

The author of the original document merely desires to see a combined version of all changes to the original document, and there is no support or disclosure in Moody et al. suggesting that the author would care of how/when the modifications were received or whether they were received through a branched email.

Rather, to overcome the fact that Moody et al. would not need such a modification, the Examiner, on pages 14-16 of the Examiner's Answer, states that "[t]he combination of Moody et al. and Office could allow the search of the inbox for the latest replied messages, branching of the original message, --email exchange history--- containing the edited documents. The original message being the parent message, and the response or replied email messages comprising the children or branches of the original message. Once found, the program disclosed by Moody would activate a comparison routine to compare the contents of the original email document to the children of branch documents, stored in the inbox, that were set by the reviewers in response to the email request by the author." (Emphasis added).

Thus, though there is no need for such a "search" operation in Moody et al., the Examiner argues that if Moody et al. were modified, then an additional search capability would be available or necessary for searching through the multiple received emails.

Again, as noted above, this is an unwarranted and unreasonable modification of Moody et al. without enabling support in the record and without sufficient evidence of success for the same.

Conversely, the Examiner is building a system from a proposed modification of Moody et al., which does not need the underlying modification, i.e., to meet all claimed elements the Examiner is proposing to continue to modify, and further modify, Moody et al. to the point that the Examiner could interpret the same as reading on the claimed features.

The fact that Moody et al. could be modified as suggested by the Examiner does not mean that such a modification is obvious.

Further, even if modified as suggested, the "searching" that would be performed within emails, presumably by an email client, for the system of Moody et al. still fails to meet the claimed detection of relevance information including the claimed email exchange of a branching of separate emails from a first email.

In this regard, the Examiner states that such a modified system would have to search through all emails to find the original email, and then search through the remaining emails to determine their heritage to the original email.

This multiple and sequential searching for information cannot be considered an email exchange history of a branching of separate emails from a first email.

Each email may have information, and a listing of emails may show the availability of multiple emails to a user, but that showing of the availability and the listing of such emails is only an exchange history of receipt between the respective senders and the receiving author, i.e., it is graphical demonstrating is only an exchange history between the sender and the receiving author and not an exchange history of the claimed branching.

Further, any searching within each email would not derive any exchange history of the claimed branching, as again that found information would only be the exchange history between that sender and the receiving author.

There is no need or reason for even the modified Moody et al. to use any exchange history information, not to mention the claimed exchange history of the claimed branching.

Use of Office 97 in Rejection

As noted above, the Examiner has based the rejection of the claims upon a proposed modification of Moody et al. based upon features discussed in Office 97, and in particular the sending of Word document content within an email and the displaying of received emails in an inbox format by an email client.

However, the focus of Moody et al. is on automated collecting comments/modifications of original document data and combining those collected comments/modifications into an easy to view combined document format.

The use of the email inbox of Office 97 or the sending of Word document content of Office 97 must be viewed from the context of the invention of Moody et al. and the desires of the inventors thereof.

As noted above, the Examiner has proposed to modify Moody et al. to place the original text within the body of an email, send emails to multiple reviewers, and then compare the email contents to the original email body. The resultant modified Moody et al. would then presumably generate some type of document to show all proposed changes to original document/email body to the user.

Any further modification of Moody et al., e.g., to use the email client's email listing function, or requiring the system to further search within each email, of apparently all emails received by the email client, for related heritage documents, would not appear sufficiently related to the purpose of Moody et al. or sufficiently enabled by the current evidence in the present application.

The Examiner has set forth remarks that if Moody et al. were modified to implement the aforementioned searching through the entire inbox of a user, then the claimed exchange history of the claimed branching emails could potentially be met. However, this searching within the inbox would appear to be far removed from the original system of Moody et al., and only necessary to implement one potential embodiment invented by the Examiner to read on the claimed invention.

Further, it is respectfully submitted that Office 97 should only be used for what it discloses to one skilled in the art, in view of the disclosure of Moody et al., and should only be used to the point that such a proposed modification of Moody et al. would be enabled by Office 97, without requiring undue experimentation and to the point that the proposed modification has a reasonable chance of success. It is submitted that the suggested Examiner modifications of Moody et al. necessary to read on all claim elements of all the claim features, as whole, are not enabled or supported by the record.

Lastly, the Examiner has maintained a number of rejections of the dependent claims arguing that Moody et al. discloses the same. However, the rejection of the dependent claims must be based upon the modified Moody et al., not on the original non-modified Moody et al..

For example, in rejecting claim 6, the Examiner has relied solely on the disclosure of Moody et al. in the creation of the single document combining the comments from multiple users, and relies upon the modified Moody et al. setting forth the locator "locating a timewise latest document related to a document based on detected relevance information" from claim 1. See page 15 of the Examiner's answer explaining how the modified Moody et al. sets forth the timewise latest document feature of claim 1.

Thus, using claims 1 and 6 as examples, the Examiner has relied upon the display within email client's listing of emails as a means for locating the timewise latest document to read on claim 1, while claim 6 sets forth that "a specific document selected among the documents displayed as a tree view by the display unit is processed as the selected document at the locator," which is rejected based upon a display of a resultant combined documents.

However, the "displaying" of claim 6 for selecting the timewise latest document as the located document cannot be physically performed before the use of the displayed email inbox for locating the timewise latest document in the rejection of claim 1, i.e., the rejection of claim 6 does not correlate to the rejection of claim 1.

Thus, if the locator of claim 1 is interpreted to be the aforementioned Examiner derived searching operation the email client's inbox, the resultant combined document of the modified Moody et al. could not have been derived yet for the tree view of the displayed combined document used in rejecting claim 6. The dependent claims do not appear to have been rejected based upon the modified Moody et al., and the Office Action's corresponding interpretation of the same to read on the independent claims.

IV. Conclusion

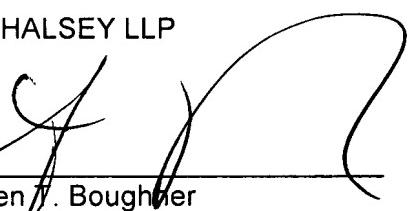
In view of the law and facts stated herein, the Appellant respectfully submits that the Examiner has failed set forth a prima facie obviousness case against the pending claims.

For all the foregoing reasons, the Appellant respectfully submits that the cited prior art does not teach or suggest the presently claimed invention. The claims are patentable over the prior art of record and the Examiner's findings of unpatentability regarding the pending claims should be reversed and the patentability over the presently cited references be affirmed.

The Commissioner is hereby authorized to charge any additional fees required in connection with the filing of this Reply Brief to our Deposit Account No. 19-3935.

Respectfully submitted,

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Dated: December 4, 2007

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